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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,837	02/06/2002	Daniel B. Roitman	10011370-1	3741

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 10/29/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,837

Applicant(s)

ROITMAN ET AL.

Examiner

Jon D Epperson

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Ric Corp
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Please note: The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to a method for “making a plurality of microbar encoders”, classified variously depending on the method steps and reagents used in class 427, subclass 2.11; class 252, subclass 301.36; class 435, subclass 6, DIG 21.
 - II. Claims 21-25, drawn to a product described as a “microbar”, classified variously depending on the materials used in class 252, subclass 301.33, 301.36; class 428, subclass 407; class 435, DIG 40-42.
2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I and II are related as process of making and product made, the inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can made by another and materially different process such as employing the use of a “template” i.e., Applicants method does not use a template (see abstract).

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4. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and products would require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

Species Election

5. This application contains claims directed to patentably distinct species of the claimed invention for Groups I-II. Election is required as follows.

6. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species. Claim 1 is generic.

Subgroup 1: Species of microbar made (e.g., see claim 1)

Applicant must elect, for the purposes of search, a ***single species*** of microbar made. Please indicate number of layers, the material in each layer and the type of signal that layer produces e.g., red-blue-yellow quantum dot, see specification, page 9, paragraph 2; see also green-red-yellow disclosed on page 20, line 13.

Subgroup 2: Species of detectable signal (e.g., see claim 1)

Applicant must elect, for the purposes of search, a ***single species*** of detectable signal e.g., visible, infrared, see page 7, line 24.

Subgroup 3: Species of method for detachment (e.g., see claim 2)

Applicant must elect, for the purposes of search, a ***single species*** of method for detachment e.g., milling, laser ablation, etc. (see page 23, line 7)

Subgroup 4: Species of removable layer (e.g., see claim 3)

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Applicant must elect, for the purposes of search, a *single species* of removable layer if present e.g., aluminum oxide (see page 19, line 12).

Subgroup 5: Species of deposition (e.g., see claim 4)

Applicant must elect, for the purposes of search, a *single species* of deposition e.g., coextrusion.

Subgroup 6: Species of transducing material (e.g., see claims 6, 7)

Applicant must elect, for the purposes of search, a *single species* of transducing material e.g., fluorescent dye, quantum dot. Please specify the material used e.g., if Applicant elects "quantum dot", Applicant must further elect the material used to make the quantum dot e.g., MgS, MgSe, etc (see page 3, line 22) for each layer used in the bar e.g., red-blue-yellow made from MgS-MgSe-CaTe.

Subgroup 7: Species of target molecule (e.g., see claims 10, 11)

Applicant must elect, for the purposes of search, a *single species* of target molecule e.g., nucleic acid, antibody.

Subgroup 8: Species of polymeric matrix (e.g., see claim 13)

Applicant must elect, for the purposes of search, a *single species* of polymeric matrix if present i.e., specify the material used.

Subgroup 9: Species of method of division (e.g., see claims 14-16)

Applicant must elect, for the purposes of search, a *single species* of method of division e.g., photolithography.

Subgroup 10: Species of probe (e.g., see claim 18)

Applicant must elect, for the purposes of search, a *single species* of probe if present.

Subgroup 11: Species of linker (e.g., see claim 18)

Applicant must elect, for the purposes of search, a *single species* of linker if present e.g., biotin (see page 14, paragraph 1).

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7. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species. Claim 21 is generic.

Subgroup 1: Species of microbar made (e.g., see claim 21)

Applicant must elect, for the purposes of search, a *single species* of microbar made. Please indicate number of layers, the material in each layer and the type of signal that layer produces if any e.g., red-blue-yellow quantum dot, see specification, page 9, paragraph 2; see also green-red-yellow disclosed on page 20, line 13.

Subgroup 2: Species of detectable signal (e.g., see claim 21)

Applicant must elect, for the purposes of search, a *single species* of detectable signal e.g., visible, infrared, see page 7, line 24.

8. **Please Note:** Applicants must disclose which claims read on the elected species (see paragraphs 12 and 13 below).
9. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ. Moreover, the above species can be separately classified. Consequently, the species have different issues regarding patentability and represent patentably distinct subject matter. Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

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10. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicant is advised that a reply to this requirement **must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered **nonresponsive** unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, **applicant must indicate which are readable upon the elected species.** MPEP § 809.02(a).

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14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

15. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Applicant is also reminded that a 1 – month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an “action on the merits” for purposes of the second action final program, see MPEP 809.02(a).

17. Finally, Applicant is reminded that where applicant elects claims directed to a product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of

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right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.
October 26, 2003

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', written over a horizontal line.